

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

NOVA MEASURING INSTRUMENTS)	
LTD.,)	
)	No. C 05-0986 MMC (BZ)
Plaintiff(s),)	
)	THIRD DISCOVERY ORDER
v.)	
)	
NANOMETRICS, INC.,)	
)	
Defendant(s).)	
)	
)	

Before the court is plaintiff Nova Measuring Instruments' motion to compel defendant Nanometrics' production of documents pursuant to Patent L.R. 3-4. The parties disagree (1) whether the documents produced must be in their native file format, with original metadata, and (2) whether the documents produced are sufficient to show the operation of each aspect or element of the claims identified in Nova's Patent L.R. 3-1(c) chart. Based on the papers submitted by both parties, I have decided that there is no need for further argument. For the following reasons, Nova's motion to compel is **GRANTED**.

1 As to the first issue, Nanometrics offers no reason why
2 the documents should not be produced in their native format.
3 Indeed, part of its opposition is that there is no need for
4 this motion because it has agreed to do so. Opp. Memo. 2:20.
5 Whether it has done so is less clear. So there is no
6 confusion, if it has not already done so, it must produce the
7 documents in their native file format, with original metadata.
8 See In re Verisign, 2004 WL 2445243 at * 1 (N.D. Cal.
9 2004)(upholding discovery orders requiring production of
10 documents in native format with metadata as not clearly
11 erroneous: "[t]he electronic version must include metadata as
12 well as be searchable'"). See also In re Honeywell
13 International, Inc., 230 F.R.D. 293, 296 (S.D.N.Y. 2003).

14 As to the second issue, Patent L.R. 3-4(a) requires the
15 party defending a claim of infringement to make available
16 "[s]ource code, specifications, schematics, flow charts,
17 artwork, formulas, or other documentation sufficient to show
18 the operation of any aspects of elements of an Accused
19 Instrumentality identified by the patent claimant in its
20 Patent L.R. 3-1(c) chart." Although not explicitly required
21 by the Patent Local Rules, no good reason exists, and none has
22 been advanced by Nanometrics, for the party opposing an
23 infringement claim not to "separately identify by production
24 number which documents correspond to each category" as is
25 explicitly required by Patent L.R. 3-2 of the party claiming
26 infringement. For disclosure to be "sufficient to show the
27 operation" it must be accompanied by the tools necessary to
28 allow the receiving party to decipher the documents and

1 discern which documents refer to which elements or aspects of
2 the accused instrumentalities. See Cryptography Research,
3 Inc. v. Visa Int'l Serv. Ass'n, 2005 WL 1787421 at * 2 (N.D.
4 Cal. 2005)(quoting Integrated Circuit Systems v. Realtek
5 Semiconductor Co., 308 F.Supp.2d 1106, 1007 (N.D. Cal. 2004)
6 in a dispute regarding Patent L.R. 3-4).

7 The patent local rules were adopted by this
8 district in order to give claim charts more
9 "bite." The rules are designed to require
10 parties to crystallize their theories of the
11 case early in the litigation and to adhere to
12 those theories once they have been disclosed.

13 Nanometrics did not comply with the letter or the spirit
14 of the Patent Local Rules. The manner in which Nanometrics
15 chose to produce the requested documents left Nova with 36,000
16 apparently unsearchable documents. Nova contends that it
17 cannot tell how the majority of the documents relate to the
18 infringement claims. See Schnapf Decl. ¶ 4. Nanometrics
19 admits that not all of the documents produced relate to the
20 claims. See Opp. Memo. 3:6-8. Nanometrics relies on its
21 cover letter to David Schnapf dated January 26, 2006 to argue
22 that it has disclosed the connection between the claims and
23 the documents produced. In the letter, Nanometrics divides
24 the documents produced, by Bates numbers, into four categories
25 such as "high-level drawings" or "specifications and manuals."
26 See Fingerman Decl., Exh. E. However, this letter does not
27 correlate the documents produced with the instrumentalities
28 accused, and as such, the letter does not link the documents
29 produced to the claims in Nova's claim chart and does not help
30 Nova crystallize its theories.

1 Accordingly, **IT IS ORDERED** that within fourteen days,
2 defendant Nanometrics shall provide plaintiff Nova Measuring
3 Instruments with the documents specified in Patent L.R. 3-
4 4(a), that such documents shall be produced in their native
5 file format, with original metadata, and that such documents
6 shall be separately identified by Bates numbers to correspond
7 to each aspect or element of each accused instrumentality
8 identified in Nova's Patent L.R. 3-1(c) chart.

9 Dated: March 3, 2006

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11 Bernard Zimmerman
12 United States Magistrate Judge

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